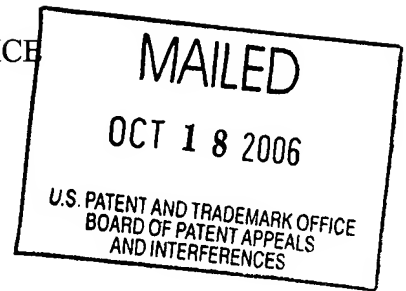


UNITED STATES PATENT AND TRADEMARK OFFICE



BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte: ROGER PROKSCH ; JASON CLEVELAND AND DAN BOCEK

Application No. 10/016,475

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was received at the Board of Patent Appeals and Interferences on October 3, 2007. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the examiner. The matters requiring attention prior to docketing are identified below.

APPEAL BRIEF

Status of Claims

Appellant filed an Appeal Brief July 6, 2006, in response to a Final Rejection mailed October 5, 2005. A review of the file reveals that the appealed claims have not been identified in the "Status of Claims" section of the brief. 37 CFR §41.37(c)(1)(iii) states:

*>(iii)< *Status of Claims*. A statement of the status of all the claims in the application, or patent under reexamination, i.e., for each claim in the case, appellant must state whether it is cancelled, allowed >or confirmed<, rejected, >withdrawn, objected to,< etc. Each claim on appeal must be identified.

Grounds of Rejection to be Reviewed on Appeal

In the “Grounds of Rejection” section of the brief a statement of the grounds of rejection was listed, however, the 103(a) statute was not included in the statement (pg. 3-4). 37 CFR §41.37(c)(1)(vi) states:

>(vi) *Grounds of rejection to be reviewed on appeal.* A concise statement of each ground of rejection presented for review. For example, the statement **“Whether claims 1 and 2 are unpatentable”** would not comply with the rule, while the statements **“Whether claims 1 and 2 are unpatentable under 35 U.S.C. 103 over Smith in view of Jones,”** and **“Whether claims 1 and 2 are unpatentable under 35 U.S.C. 112, first paragraph, as being based on a nonenabling disclosure”** would comply with the rule. The statement cannot include any argument concerning the merits of the ground of rejection presented for review. Arguments should be included in the “Argument” section of the brief.

It should be noted that the appendix heading is properly identified as “Grounds of Rejection to be Reviewed on Appeal.”

Claims Appendix

The “Claims Appendix” includes inappropriate markings for claims 65, 67 and 68. 37 CFR §41.37(c)(1)(viii) states:

>(viii) *Claims appendix.* An appendix containing a copy of the claims involved in the appeal.

The copy of the claims **should be a clean copy and should not include any markings** such as brackets or underlining except for claims in a reissue application. See MPEP § 1454 for the presentation of the copy of the claims in a reissue application.

EXAMINER’S ANSWER

Evidence Relied Upon

The Evidence Relied Upon section of the Examiner’s Answer mailed October 27, 2006, is defective. The “Arguments’ section (pg. 6, 7 and 8) includes Neff, 4,030,085, Snow U.S. 2,503,851, Yashohama et al. US 5,432,444, Dickmeyer et al. US 5,381,089, Redlich U.S.

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4,667,158, Neff U.S. 2,364,237 and Neff et al. 6,043,573 as supporting evidence and must be included in the “Evidence Relied Upon” section.

In accordance with MPEP § 1207.02, the “Evidence Relied Upon” should include:

A listing of the **>evidence< relied on >(e.g., patents, publications, admitted prior art)<, and, in the case of nonpatent references, the relevant page or pages.

Correction is required.


CONCLUSION

Accordingly, it is

ORDERED that the application is returned to the Examiner to:

- 1) hold the Appeal Brief filed July 6, 2006, defective;
- 2) notify the appellant to submit a “paper” which corrects the Status of Claims, Grounds of Rejection to be Reviewed on Appeal and Claims Appendix under 37 CFR §41.37(c)(1)(iii), 37 CFR §41.37(c)(1)(vi) and 37 CFR §41.37(c)(1)(viii);
- 3) acknowledge and consider any “paper” that may be submitted by Appellant in response to the Notice of Non-Compliance to correct the Appeal Brief ;
- 4) issue and mail a PTOL-90 that acknowledges any “paper” filed by Appellant and may include correction of the Examiner’s Answer (Evidence Relied Upon section);
- 5) have a copy of the “paper” scanned into IFW; and
- 6) for such further action as may be appropriate.

BOARD OF PATENT APPEALS
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